

REMARKS

I. Introduction

The following issues are outstanding with respect to the pending application:

- Claims 9-11, 14-17 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication No. 2002/0073039 to Ogg et al (hereinafter *Ogg*) in view of US Patent Publication No. 2001/0037320 to Allport et al (hereinafter *Allport*) and in further view of US Patent Application No. 2003/0014376 to DeWitt et al (hereinafter *DeWitt*).
- Claims 18, 19, 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication No. 2002/0073039 to Ogg et al (hereinafter *Ogg*) in view of US Patent Publication No. 2001/0037320 to Allport et al (hereinafter *Allport*) and in further view of US Patent Application No. 2003/0014376 to DeWitt et al (hereinafter *DeWitt*).
- Claims 24-29, 33, 34 and 36-40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication No. 2002/0073039 to Ogg et al (hereinafter *Ogg*) in view of US Patent Publication No. 2003/0014376 to DeWitt et al (hereinafter *DeWitt*).
- Claims 31, 32 and 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication No. 2002/0073039 to Ogg et al (hereinafter *Ogg*) in view of US Patent Publication No. 2001/0037320 to Allport et al (hereinafter *Allport*) and in further view of US Patent Application No. 2003/0014376 to DeWitt et al (hereinafter *DeWitt*).

Applicant respectfully traverses the rejections of record and requests reconsideration in light of the amendments and remarks contained herein. Claims 9-11, 14-29, 31-34, and 36-43 are pending in the present application.

II. Examiner Interview Summary

Applicant thanks Examiner Rob Wu for the telephonic Examiner Interview of November 18, 2009. During the interview, claim amendments were discussed and it was agreed that amending the claims (as amended herein) would overcome the *Ogg / Allport / DeWitt / Leon* combination. Moreover, it was agreed that the amendments were supported at least by paragraph [0028] of the originally filed specification. As such, the claims have been amended as agreed. Because the amended claims are nonobvious over *Ogg* in view of *Allport* in view of *DeWitt* in view of *Leon*, Applicant requests the rejections of record be withdrawn and the claims be allowed.

III. Claim Amendments

Claims 9, 24, and 42 are amended herein. Support for the amendments can be found in the originally filed specification (e.g. para. [0028]); thus, the amendments include no new matter. As such, Applicant requests the amendments be entered.

IV. 35 U.S.C. § 103 Rejections

The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art. The United States Supreme Court in *Graham v. John Deere and Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. As discussed further hereafter, Applicant respectfully asserts that the claims include non-obvious differences over the cited references. Thus, the rejections should be withdrawn because when considering the scope and content of the applied references there are significant differences between the applied combination and rejected claims, as the applied combination fails to disclose all elements of the rejected claims.

Due to the issues discussed in the Examiner Interview, independent claim 42 will be discussed first herein. Applicant traverses all rejections of the record.

1. Independent Claim 42

Claim 42 recites in part “affixing the machine generated postage stamp to the mail pieces to provide mail pieces processed by the high speed mail item computer processing system that have the appearance of a mail piece comprising a postage stamp obtained from a delivery service that was applied by hand.” The Office Action relies on the combination of *Dewitt* and *Leon* in teaching this limitation. Office Action at 10-11.

Claim 42 also recites “printing ... said machine generated postage stamp including a postage indicium and an image ... wherein the image is selected based on characteristics of a recipient of the particular one of the plurality of mail pieces” The Office Action relies on *Allport* as teaching printing a machine generated postage stamp including an image selected based receipting characteristics. Office Action at 10.

However, the *DeWitt / Leon / Allport* combination fails to make the quoted limitations obvious, because the *DeWitt / Leon* combination as modified by *Allport* do not teach the limitations. Specifically, the *DeWitt / Leon* combination is relied on as teaching affixing a postage stamp; however, the *DeWitt / Leon* does not teach the image is selected based on characteristics of a recipient. Modifying *DeWitt / Leon* with *Allport* fails to cure the deficiency because while *Allport* teaches that an advertising section may include an image based on recipient characteristics, *Allport* explicitly states that the advertising image is not part of the indicia and is printed in a different location. *Allport* at [0034]. Moreover, *Allport* explicitly states that the image within the printed indicia is fixed and can **not** be changed; therefore, the indicia image can not be based on the taught recipient characteristic image. *Allport* at [0033]. Thus, if *Leon* printed indicia for *DeWitt / Leon* to affix, the indicia could not include *Allport*'s recipient characteristic based image because *Allport* explains the indicia can not include that image.

As such, the *DeWitt / Leon / Allport* combination fails to teach “printing ... said machine generated postage stamp including a postage indicium and an image ... wherein the image is selected based on characteristics of a recipient of the particular one of the plurality of mail pieces ... affixing the machine generated postage stamp to the mail pieces to provide mail pieces processed by the high speed mail item computer processing system that have the appearance of a mail piece comprising a postage stamp obtained from a delivery service that

was applied by hand.” Furthermore, *Ogg* fails to cure the deficiency. As a result, Applicant respectfully requests the rejection of record be withdrawn and the claim be allowed.

B. Independent claims 9 and 24

Claim 9 recites in part “printing ... valid postage labels, wherein each of the valid postage labels comprise an image ... wherein the image is selected based upon one or more characteristics of the particular recipient; and applying, by said high speed mail item processing computer system, said valid postage labels to said particular one of the plurality of mail pieces, wherein said mail pieces have an appearance of a mail item comprising a postage stamp that was obtained from a delivery service and was applied by hand, wherein said appearance of said mail item comprising a postage stamp that was obtained from a delivery service and was applied by hand is achieved at least in part by said valid postage labels being formatted as said postage stamp that was obtained from said delivery service.” Independent claim 24 recites “printing ... valid postage labels comprising postage indicia ... comprising images, ... wherein said images of at least two of the valid postage labels are not identical; [and] applying, by said high-speed letter processing system, the valid postage labels to the associated mail pieces wherein said associated mail pieces have an appearance of a mail item comprising a postage stamp that was obtained from a delivery service and was applied by hand.”

The Office Action cites the *Ogg / Allport / DeWitt* combination as teaching claim 9 and cites the *Ogg / DeWitt* combination as teaching claim 24. Office Action at 3-4 and 13. However, the combinations fail to disclose the valid postage labels appear to have been obtained from a postal service and appear to have been applied by hand. Thus, the relied upon combinations fail to teach the claims.

Moreover, the *Ogg / Allport / DeWitt / Leon* combination fails to make the claims obvious, as explained above regarding claim 42. Thus, Applicant requests the rejections of record be withdrawn and the claims be allowed.

C. Dependent claims

Dependent claims 10-11, 14-23, 25-29, 31-34, 36-41, and 43 are rejected as being obvious under various combinations of the *Ogg / Allport / DeWitt / Leon* references. However, each of dependent claims 10-11, 14-23, 25-29, 31-34, 36-41, and 43 depend from independent claims 9, 24, and 42, respectively. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP 2143.03. As shown above, the independent claims are nonobvious in light of the *Ogg / Allport / DeWitt / Leon* combination. Thus, the dependent claims are likewise nonobvious. Accordingly, Applicant requests the rejections of record be withdrawn and the claims be allowed.

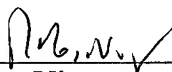
V. Conclusion

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. Please charge any fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 61135/P022US/10303187 from which the undersigned is authorized to draw.

Dated: December 23, 2009

Respectfully submitted,

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